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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,686	03/10/2000	Takaaki Nagae	1046.1211/JDH	5906

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EXAMINER

HILLERY, NATHAN

ART UNIT PAPER NUMBER

2176

DATE MAILED: 10/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/522,686	<b>Applicant(s)</b> NAGAE, TAKAAKI	
	<b>Examiner</b> Nathan Hillery	<b>Art Unit</b> 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4-9,12-17 and 20-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-9,12-17 and 20-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/10/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications: RCE filed on 7/23/04.
2. Claims 1, 4 – 9, 12 – 17, and 20 – 24 are pending in the case. Claims 1, 9 and 17 are independent.
3. The rejection of claims 1 – 24 under 35 U.S.C. 103(a) as being unpatentable has been withdrawn as necessitated by amendment.

### ***Priority***

4. Applicant is advised of possible benefits under 35 U.S.C. 119(a)-(d), wherein an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in a foreign country.
5. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
6. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 1, 4, 8, 9, 12, 16, 17, 20, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson [SinaNet] (as previously cited) and further in view of Aiba et al. (US 5428458 A).

9. **Regarding independent claims 1, 9, and 17**, Jackson teaches that *an internet company has developed a system that it claims can receive and read Chinese-language e-mail* (lines 1 – 2), which provide for **receiving a sentence serving as contents of an electronic mail**. Jackson also teaches that *SinaNet has two coding standards for translating the characters, known as Big-5 for traditional and GB for simplified. A Big-5 user cannot read text generated by someone using GB and vice versa ... SinaNet's SinaXpress application has modules that translate between Big-5 and GB and make either format into a .GIF file for display on English-language browsers* (lines 23 – 28), which provide for **forming the image data of the sentence when it is judged that the image data of the sentence should be formed; and transmitting the electronic mail with the formed image data of the sentence to the destination of the electronic mail**. Jackson does not explicitly teach **judging whether to form an image data of the sentence based on the information read out from said storing unit and reading information....** However, Aiba et al. teach that *still another object of the invention is to provide an image communicating apparatus in which in case of transmitting code data, a function and a line state of an apparatus on the partner side are discriminated and, in accordance with the result of the discrimination, either one of a mode to directly transmit the code data and a mode to convert the code data into the image data and to transmit the converted image data is selected* (Column 1, lines 59 –

66), and that *since the telephone number has already been designated from the operation unit, the facility of the partner apparatus is judged from the telephone number stored in the backup memory 417 in a manner as mentioned in the first embodiment. When the partner apparatus doesn't have the developing facility of LIPS II, the data is transferred from the file unit 5 to the formatter 8 and is developed into the image and, after that, the image data is transmitted to the memory of the facsimile unit 4. When the partner apparatus has the developing facility of LIPS II, the state of the line stored is subsequently judged. When it is determined that the data cannot be transmitted by the PDL due to the preceding information stored in the backup memory 417, the data is also developed into the image and the image data is transmitted* (Column 16, line 55 – Column 17, line 2), which provide for **judging whether to form an image data of the sentence based on the information read out from said storing unit and reading out information in response to a destination of the electronic mail from a storing unit, the information indicating whether a sentence to be included in the contents of the electronic mail is text-displayable based on text data on the basis of a character code system used at the destination of the electronic mail**. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Jackson with that of Aiba et al. because such a combination would allow the users of SinaNet (Jackson) the benefit of *an image communicating apparatus comprising a reader as an image input unit for inputting code data such as character code or the like* (Abstract, lines 1 – 3).

10. **Regarding dependent claims 4, 12, and 20**, Jackson teaches that *SinaNet* has two coding standards for translating the characters, known as Big-5 for traditional and GB for simplified. A Big-5 user cannot read text generated by someone using GB and vice versa ... *SinaNet's SinaXpress* application has modules that translate between Big-5 and GB and make either format into a .GIF file for display on English-language browsers (lines 23 – 28), which provide for **displaying the sentence on a screen using text data of the sentence wherein, in the forming image data, image data corresponding to the sentence written in a format displayed on the screen is formed.**

11. **Regarding dependent claims 8, 16, and 24**, neither Jackson nor Aiba et al. explicitly teach that **the image data is transmitted as an attached file to the destination of the electronic mail.** However, it would have been obvious to one of ordinary skill in the art at the time of the invention to know that most Web e-mail services have the capability to attach any file to an e-mail message.

12. Claims 5 – 7, 13 – 15, and 21 – 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson (as previously cited) and Aiba et al. (US 5428458 A) as applied to claims 1, 4, 8, 9, 12, 16, 17, 20, and 24 above, and further in view of Flanagan et al. (as previously cited).

13. **Regarding dependent claims 5, 13, and 21**, neither Jackson nor Aiba et al. explicitly teach **translating the sentence into a language used in the destination when the sentence is expressed by characters written in a language different**

**from the language used in the destination of the electronic mail, wherein translation results are transmitted to the destination of the electronic mail.**

However, Flanagan et al. do teach that *the present invention is a system of parallel discussion groups operated in conjunction with a message collection/posting software program, data filter software program, and a machine translation software program* (Column 2, lines 21 – 24) and that *some of the messages on a French version of a discussion group will have been originally written in French whereas many will be translations of messages which were originally written in a different language. Each of the messages translated from another language version of the parallel discussion group may contain both the translated message and the original language text. For example, a message originally written in the English version of the discussion group and translated to the French version may be shown on screen with the original English text in addition to the French translation* (Column 3, lines 3 – 13). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions disclosed by Jackson, Aiba et al. and Flanagan et al. because such a combination would allow the users of SinaNet (Jackson) and the invention of Aiba et al. access to *machine translators and other software incorporated to translate messages, thereby creating parallel discussion groups in different languages* (Abstract).

14. **Regarding dependent claims 6, 14, and 22**, the claims incorporate substantially similar subject matter as claims 1, 5, 9, 13, 17, and 21, and are rejected along the same rationale.

15. **Regarding dependent claims 7, 15, and 23**, Jackson teaches that *SinaNet* has two coding standards for translating the characters, known as Big-5 for traditional and GB for simplified. A Big-5 user cannot read text generated by someone using GB and vice versa ... *SinaNet's SinaXpress* application has modules that translate between Big-5 and GB and make either format into a .GIF file for display on English-language browsers (lines 23 – 28), and Flannagan et al. teach that some of the messages on a French version of a discussion group will have been originally written in French whereas many will be translations of messages which were originally written in a different language. Each of the messages translated from another language version of the parallel discussion group may contain both the translated message and the original language text. For example, a message originally written in the English version of the discussion group and translated to the French version may be shown on screen with the original English text in addition to the French translation (Column 3, lines 3 – 13), which provide for **in the forming image data, translated image data of the translation results expressed by characters written in the language used in the destination is formed when it is determined that the characters are not written in the text-displayable language used in the destination of the electronic mail, and the electronic mail transmission method further comprises forming synthesized image data obtained by combining the formed image data corresponding to the sentence with the translated image data, and in the transmitting, the synthesized image data is transmitted to the destination of the electronic mail.** It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the



inventions disclosed by Jackson, Aiba et al. and Flanagan et al. because such a combination would allow the users of SinaNet (Jackson) and the invention of Aiba et al. access to *machine translators and other software incorporated to translate messages, thereby creating parallel discussion groups in different languages* (Abstract).

### **Response to Arguments**

16. Applicant's arguments with respect to claims 1, 9, and 17 have been considered but are moot in view of the new ground(s) of rejection.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (703) 305-4502. The examiner can normally be reached on M - F, 6:30 a.m. - 3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JOSEPH FEILD  
SUPERVISORY PATENT EXAMINER

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